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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/843,166 | 04/27/2001 | Mitchell Corner | P 280189 50684/USw | 8587 |

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| EXAMINER |
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MCAVOY, ELLEN M

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| ART UNIT | PAPER NUMBER |
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1764

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/843,166

Applicant(s)

CORNER ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preliminary amendment filed April 27, 2001, amended independent claim 1 contained an incorrect formula as component (1); the formula



is incorrect. The correct formula, as set forth in original claim 1, is



Also, independent claim 1 contains the misspelling "polya;ky;ene" for polyalkylene. Correction is required.

Claim Rejections - 35 USC § 103

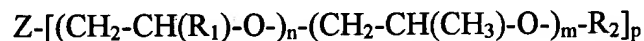
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw et al (4,851,144) and Ward et al (RE 33,658), considered separately.

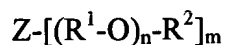
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McGraw et al ["McGraw"] disclose lubricant base oil compositions for compression refrigeration which comprise (A) about 95 to 5% by weight of a polyether polyol having a number average molecular weight from about 400 to about 5000 and having the formula



and (B) about 5 to 95% by weight of esters made from polyhydric alcohols with alkanolic acids or esters made from alkanedioic acids with alkanols. See column 2, lines 1-32. The examiner is of the position that component (A) of McGraw meets the limitation of component (1) of applicants' claims when n is 0, R₂ is methyl and when Z is derived from methanol, ethanol, propanol and butanol as set forth in column 2, lines 51 to column 3, line 12. The examiner is of the position that component (B) of McGraw meets the limitation of component (2) of applicants' claims when component (2) is an ester selected from a polyol ester or an aliphatic diacid ester. McGraw allows for the addition of conventional additives to the composition such as antioxidants and corrosion inhibitors. Although antifoam additives are not cited by McGraw, the examiner is of the position that it would have been obvious to have added any conventional additive to the composition such as antifoam agents.

Ward et al ["Ward"] disclose synthetic lubricants comprising (A) about 15 to 45 weight % of an ester of a monohydric alcohol of 4 to 18 carbon atoms with one or more aromatic or alkane dicarboxylic acids having 4 to 18 carbon atoms, and (B) about 85 to 55 weight % of one or more polyether polyols having a number average molecular weight from about 400 to 5000 and having the formula



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wherein Z is the residue of a compound having 1-8 hydroxyl groups, R^1 is an alkylene radical having 2 to 4 carbon atoms, and R^2 is hydrogen or an alkyl group of 1 to 6 carbon atoms.

Suitable monohydric compounds for Z include methanol, ethanol, propanol and butanol. See column 2, lines 63-67. Ward also allows for the addition of conventional additives and "any such additives as may be required". See column 3, lines 25-31. Thus, the examiner is of the position that the synthetic lubricants of Ward meets the limitations of the claims.

Conclusion

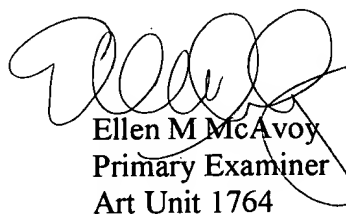
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
December 4, 2001